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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,950	03/13/2001	Satoshi Banno	Q63572	9028

7590 09/23/2004

SUGHRUE, MION, ZINN
MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

CHUONG, TRUC T

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,950

Applicant(s)

BANNO, SATOSHI

Examiner

Truc T Chuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the Amendment, filed 07/21/04.
2. Claims 1-5, and 8-14 are pending in this application. Claims 1-5, and 11-14 are independent claims. In the Amendment, independent claims 1, 3, 5, 11, 13, and 14 are amended, and claims 6-7 are cancelled. This action is made final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 102

1. Claims 1-5, and 8-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Murray (U.S. Patent No. 6,392,668 B1).

As to claim 1, Murray teaches a portable information terminal device comprising:

a receiving means for receiving information via a network (receiving information such as Web pages from a Network, e.g., col. 3 lines 38-58, col. 4 lines 1-10, and figs. 3-4);

plural display means for displaying the information received by the receiving means (more than one Web pages can be displayed on the Web Browser, e.g., col. 4 lines 1-5, col. 5 lines 23-35);

a memory means for storing predetermined identification codes (e.g., col. 4 lines 10-28, using memory portion 260 in which the identifiers provided by provider 140, col. 6 lines 27-40, and col. 8 lines 17-32);

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a detecting means for detecting whether or not the information received by the receiving means includes the identification codes stored in the memory means ("Each identifier corresponds to a participating provider. In the user's local processing system, the network code is then parsed and any occurrence in the network code of any identifier stored in the list of identifiers is detected. For each detected identifier, a marker code is then inserted into the network code, the marker code indicating to the user the presence in the network code of each detected identifier", sic, Summary, and col. 10 lines 20-32); and

a display control means for displaying the information on selected ones of said plural display means on the basis of the detection result of the identification codes of the detecting means (insert appropriate markers into view pages or different Web pages, e.g., col. 7 lines 1-5, col. 8 lines 33-67, col. 10 lines 20-57, and figs. 3-4).

As to claim 2, Murray teaches a portable information terminal device comprising:

a receiving means for receiving information via a network; plural display means for displaying the information received by the receiving means; a memory means for storing predetermined identification codes; a detecting means for detecting whether or not the information received by the receiving means includes the identification codes stored in the memory means; and a display control means for displaying the information on selected ones of said plural display means on the basis of the detection result of the identification codes of the detecting means (Note the rejection of claim 1 above),

said detecting means detects predetermined first and second identification codes and the control means selects any of the display means to display the information sandwiched between the first and second identification codes (insert appropriate markers

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into view pages or different Web pages/links, e.g., col. 7 lines 1-5, col. 8 lines 33-67, col. 10 lines 20-57, and figs. 3-4).

As to claim 3, Murray teaches a portable information terminal device comprising:

a receiving means for receiving information via a network; a memory means for storing predetermined identification codes; a detecting means for detecting whether or not the information received by the receiving means includes the identification codes stored in the memory means (Note the rejection of claim 1 above);

an extracting means for extracting address data linked to different information from the received information on the basis of the detection result of the identification codes of the detecting means (insert appropriate markers into view pages or different Web pages/links, e.g., col. 7 lines 1-5, col. 8 lines 33-67, col. 10 lines 20-57, and figs. 3-4); and

an obtaining means for obtaining the different information linked to the address data extracted by the extracting means (e.g., col. 7 lines 1-5, col. 8 lines 33-67, col. 10 lines 20-57, and figs. 3-4).

As to claim 4, Murray teaches portable information terminal device comprising:

a receiving means for receiving information via a network; a display means for displaying the information received by the receiving means; a memory means for storing predetermined identification codes; a detecting means for detecting whether or not the information received by the receiving means includes the identification codes stored in the memory means (Note the rejection of claim 1 above);

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an extracting means for extracting address data linked to different information from the received information on the basis of the detection result of the identification codes of the detecting means (insert appropriate markers into view pages or different Web pages, e.g., col. 7 lines 1-5, col. 8 lines 33-67, col. 10 lines 20-57, and figs. 3-4);

a display control means for permitting the display means to display icons corresponding to the address data extracted by the extracting means (icons and other display features, e.g., col. 9 lines 33-65, and figs. 3-4);

an accepting means for accepting a selection of the icons displayed on the display means (using links as identifiers is that the user can then, using conventional browsers, "click on" them, that is, select a link using the cursor-control device 116, whereupon the browser will automatically access the site corresponding to the selected link, sic, col. 8 lines 17-24, and figs. 3-4); and

an obtaining means for obtaining the different information linked to the address data corresponding to the icons when the accepting means accepts the selection of the icons (selecting, e.g., col. 8 lines 17-24, col. 9 line 33-65, and figs. 3-4).

As to claim 5, Murray teaches a portable information terminal device comprising:

a receiving means for receiving information via a network; plural display means for displaying the information received by the receiving means; a memory means for storing predetermined identification codes; a first detecting means for detecting whether or not the information received by the receiving means includes the identification codes stored in the memory means; an extracting means for extracting address data linked to different information from the received information on the basis of the detection result of

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the identification codes of the first detecting means; a first display control means for displaying icons on selected ones of said plural display means corresponding to the address data extracted by the extracting means; an accepting means for accepting a selection of the icons displayed on the display means; an obtaining means for obtaining the different information linked to the address data corresponding to the icons when the accepting means accepts the selection of the icons (Note the rejection of claims 1 and 4 above);

a second detecting means for detecting whether or not the different information obtained by the obtaining means includes the identification codes stored in the memory means (a different search topic will contain a different marker/icon/ad corresponding to the new search topic, and so on. See above for similar rejection); and

a second display control means for permitting any of the display means to display the different information on the basis of the detection result of the identification codes of the second detecting means (using more than one Web pages to view/search/navigate on different topics, see above for similar rejection).

As to claims 8-10, Murray teaches the portable information terminal device claimed in claim 3, wherein the address data extracted by the extracting means is sandwiched between predetermined first and second identification codes (insert appropriate markers into view pages or different Web pages/links, e.g., col. 7 lines 1-5, col. 8 lines 33-67, col. 10 lines 20-57, and figs. 3-4).

As to claim 11, it is individually similar in scope to claim 1 above; therefore, rejected under similar rationale.

As to claims 12-14, they are similar in scope to claim 1 and 5 above; therefore, they can be rejected under similar rationale as claims 1 and 5 above.

Response to Arguments

1. Applicant's arguments filed 05/06/04 have been fully considered but they are not persuasive.

Applicants argued the following:

- a. The computer system of Murray is not a portable information terminal.
- b. Murray does not teach "plurality display means."
- c. Detecting/Inserting a marker code/icon of Murray is different from predetermined first and second identification codes as claimed by the Applicant.
- d. Murray does not clearly show the information "sandwiched" between codes.

The Examiner disagrees for the following reasons:

Per (a), in response to applicant's arguments, the recitation "portable information terminal device" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951); furthermore, it would have been obvious to modify the features taught by the Personal Computer of Murray in a portable terminal such as

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Computer Laptops, Notebook Computers, PDAs, etc., which nowadays contain more than enough memory and processing speed to perform similar functions of any regular PC, for easy to mobile from place to place.

Per (b), Murray clearly teaches the ability of displaying more than one Web pages/links/icons on a Web Browser (e.g., col. 4 lines 1-5, col. 5 lines 23-35) means a plurality of display (Web pages) can be displayed on one screen; moreover, in the Specification, the Applicant does not clearly point out whether there are two separate physical displays on a single monitor or only two portions nearby on the display (such as two Web pages/Applications/Programs/Images) on a single screen display (a Web Browser on a single monitor).

Per (c), after detecting and identifying the current data against the loaded identifiers storing in local system or other location in the same Network (col. 4 lines 10-44), Murray's system only inserts appropriate markers into view pages or different Web pages/links (e.g., col. 7 lines 1-5, col. 8 lines 33-67, col. 10 lines 20-57, and figs. 3-4) for the current users of the system.

Per (d), Note the rejection of claim 2 above and how the appropriate markers insert between Web pages (Per (c)).

All other arguments are related or similar in scope to those above.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T Chuong whose telephone number is 703-305-5753, and

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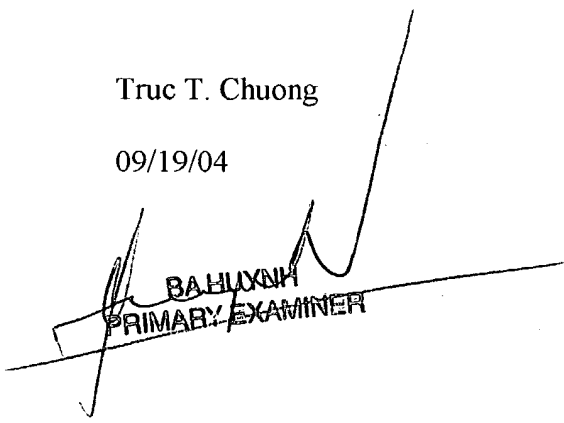
starting October 2004, a new telephone number will be 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 703-308-5186, and starting October 2004, a new telephone number will be 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

09/19/04


BAHUYNN
PRIMARY EXAMINER